

REMARKS

In the Office Action dated November 14, 2006, the Examiner rejected claims 1-39 under 35 U.S.C. § 101 as lacking patentable utility; rejected claims 1-5, 8, 9, 11-17, 21, 23-29, 32, 33, and 35-39 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,370,514 to Messner ("*Messner*");¹ rejected claims 6, 18, and 30 under 35 U.S.C. § 103(a) as unpatentable over *Messner* in view of U.S. Patent No. 6,615,189 to Phillips et al. ("*Phillips*"); and objected to claims 7, 10, 19, 22, 31, and 34 as dependent upon rejected base claims but allowable if rewritten in independent form.

Applicant has amended claims 1, 13, and 25, and canceled claims 6, 7, 18, 19, 30, and 31. Upon entry of this amendment, claims 1-5, 8-17, 20-29, and 32-39 will be pending and under current examination.

I. The Rejection of Claims 1-39 Under 35 U.S.C. § 101

The Examiner states that claim 1 recites a "method [] performed within [a] processor except when perhaps receiving information from a consumer, [and] does not produce a tangible outcome." (Office Action at p. 2). Amended claim 1 recites, among other things, a method, performed by a processor, for providing a financial card to at least one recipient for a consumer, including "converting an account associated with the delivered financial card into a credit card account." Converting an account into a credit card account is a concrete, useful, and tangible result. (See MPEP § 2106, citing *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373).

Claim 1, therefore, recites statutory subject matter.

¹ The Examiner rejects claim 30 in the basis of rejection but does not address this claim in the body of the rejection. Accordingly, Applicant assumes the Examiner did not intend to reject claim 30 under 35 U.S.C. § 102(b).

Independent claims 13 and 25 were rejected for the same reasons discussed above with respect to independent claim 1 (Office Action at p. 2). However, amended claim 13, as noted by the Examiner, is a system claim. Accordingly, the Examiner's position regarding the method recited in claim 1 is not applicable to claim 13. Indeed, claim 13 recites a system that demonstrates utility and is statutory. Further, claim 25, although of different scope than independent claim 1, recites subject matter similar to that discussed above with respect to claim 1, and therefore recites statutory subject matter.

Claims 2-12, 14-24, and 26-39 were rejected solely due to their dependence from independent claims 1, 13, and 25, respectively. As claims 1, 13, and 25 recite statutory subject matter, dependent claims 2-12, 14-24, and 26-39 also recite statutory subject matter. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-39 under 35 U.S.C. § 101.

II. The Rejection of Claims 1-5, 8, 9, 11-17, 21, 23-29, 32, 33, and 35-39 under 35 U.S.C. § 102(b)

Applicant respectfully disagrees with the rejection of claims 1-5, 8, 9, 11-17, 21, 23-30, 32, 33, and 35-39. Nevertheless, in an effort to expedite prosecution, Applicant has amended the independent claims to incorporate subject matter that the Examiner indicated is allowable. For instance, the Examiner indicated that claims 7, 19, and 31 contain allowable subject matter (Office Action at p. 5). Therefore, independent claim 1 has been amended to incorporate the recitations of allowable claim 7 and intervening claim 6, independent claim 13 has been amended to incorporate the recitations of

allowable claim 19 and intervening claim 18, and independent claim 25 has been amended to incorporate the recitations of allowable claim 31 and intervening claim 30.

Claims 2-5, 8, 9, 11, 12, and 37 depend from claim 1, claims 14-17, 21, 23, 24, and 38 depend from claim 13, and claims 26-29, 32, 33, and 39 depend from claim 25, and are allowable at least due to their dependence from allowable independent claims. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-5, 8, 9, 11-17, 21, 23-29, 32, 33, and 35-39 under 35 U.S.C. § 102(b), and allow the claims.

II. The Rejection of Claims 6, 18, and 30 under 35 U.S.C. § 103(a)

Claims 6, 18, and 30 have been cancelled, rendering the rejection moot.

III. The Objection to Claims 7, 10, 19, 22, 31, and 34

Claims 7, 19, and 31 have been cancelled, rendering the objection moot with respect to these claims. Claims 10, 22, and 34 depend from independent claims 1, 13, and 25, respectively, and were objected to for being dependent upon rejected base claims (Office Action at p. 5). As discussed above, amended independent claims 1, 13, and 25 are allowable. Applicant therefore respectfully requests the Examiner to withdraw the objection to claims 7, 10, 19, 22, 31, and 34, and allow claims 10, 22, and 34.

IV. Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 12, 2007

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